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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,038	12/15/2006	Josef Schneider	407PUS	9342
27799 7590 03/29/2010 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,038	Applicant(s) SCHNEIDER ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01-26-2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2010 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The replacement sheet of drawings was received on January 26, 2010. This replacement sheet is approved by the Examiner.

Claim Objections

4. Claims 32-43 are objected to because of the following informalities:

With respect to claim 32, line 11, it is suggested that the phrase --that is used-- be inserted before "for" to insure the claim language is clear with respect to the functionality "color" since the language "for producing the static or unchanging image" is somewhat confusing as to whether it is modifying the recited "at least one functionality" or the functionality "color". For the sake of furthering prosecution, It has been assumed by the Examiner that it is modifying the functionality "color" and therefore the suggested language makes the relationship more clear. If it is intended to modify the "at least one functionality" than it would appear that the term "static or unchanging" should be deleted and replaced with --dynamic or changing--.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any

Art Unit: 2854

inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumaru et al. (JP 08-290543 A) in view of Fuhrmann et al. (US 6,631,677 B1).

With respect to claim 32, Katsumaru et al. teach a device for printing on a substrate, the device comprising at least one printing unit B, B1 configured to print a static or unchanging image on the substrate 1, at least one printing device 9, installed inline with the at least one printing unit B, B1, and configured to individualize the static image by adding at least one dynamic or changing image to the substrate, each the at least one printing device 9 used to print at least one dynamic or changing image receiving a data stream (via controller 10) containing data for the at least one dynamic or changing image; wherein the image information is printed inline of the substrate in a single workflow. See, in particular, Figure 1 and the attached partial English language translation.

With respect to the language added to claim 32 regarding the printing device being used to print at least one functionality different from a functionality "color" which is used for producing the static or unchanging image, it is noted that claim 32 is an apparatus claim and this language is merely a functional recitation of a desired mode of operation of the printing device and recites no additional structural limitation necessary to provide that function. Therefore, since Katsumaru et al. teach a printing device having all of the structure as recited, it is broadly capable of being used to print any desired functionality (such as one different from the functionality "color" used to produce the static or unchanging image) to provide different image characteristics to the dynamic or changing image.

Furthermore, Katsumaru et al. is silent with respect to the details of how the static or unchanging image is formed in the printing unit and whether the unit is configured to receive a data stream containing data for the static or unchanging image. However, printing units configured to receive data for the static or unchanging image and to perform in-press imaging of the print drum are well known in the art as exemplified by the press of Fuhrmann et al. In view of this teaching, it would have been obvious to provide the printing unit of Katsumaru et al. to be configured to receive a data stream containing data for the static or unchanging image as taught by Fuhrmann et al. to allow for a more versatile printing device that is capable of in-press imaging of the plate drum.

With respect to claim 33, note the printing unit for the static or unchanging image of Katsumaru et al. is an offset press B, B1 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 34, note the printing device for the dynamic or changing image in Katsumaru et al. is an ink-jet printer 9 as shown in Figure 1 and described in paragraph [0010] of the attached partial English language translation.

With respect to claim 35, Katsumaru et al. in view of Fuhrmann et al. teach a device as recited with the exception of the at least one printing device used to print the dynamic or changing image being based on the principle of electrophotography, magnetography, electrocoagulation, or ionography. However, the use of these various types of digital printing devices to print image information is well known in the art. In view of this, it would have been obvious to one of ordinary skill in the art to provide at least one printing device based upon the principle of electrophotography, magnetography, electrocoagulation or ionography in the device of Katsumaru et al. in view of Fuhrmann et al. as it would simply require the obvious substitution of one known digital image printing device for another. Furthermore, the system of Katsumaru et al. in view of Fuhrmann et al. would perform equally well with a printing system based upon electrophotography, magnetography, electrocoagulation, or ionography

Art Unit: 2854

instead of an inkjet printing device to provide the dynamic or changing image on the substrate.

With respect to claim 36, note the device of Katsumaru et al. in view of Fuhrmann et al. can broadly be considered to include a control unit that can broadly be considered to be either "open-loop" or "closed-loop" as recited.

With respect to claim 37, note the device of Katsumaru et al. as modified by Fuhrmann et al. would inherently include at least three data streams. In particular, note Katsumaru et al. teaches the device can include a plurality of inkjet heads (see paragraph [0015]) and there would clearly be a data stream of image information required for each inkjet head. Furthermore, note the printing unit of Katsumaru et al. as modified by Fuhrmann et al. is a double-sided print unit and therefore would require multiple data streams of image information in order for each plate cylinder to be imaged. Thus, the device of Katsumaru et al. in view of Fuhrmann et al. includes three data streams as recited.

With respect to claims 38-43, again it is noted that the functionality is not part of the positively claimed structure of the printing device and therefore the printing device of Katsumaru et al. is capable of being used to print any desired functionality, such as text data, image data, logistics data, fragrances, varnishes, electrical conductors, or semiconductor circuits, to provide different image characteristics to the dynamic or changing image.

Response to Arguments

8. Applicant's arguments filed January 26, 2010 have been fully considered but they are not persuasive of any error in the above rejections.

Applicant argues that Katsumaru et al. fail to teach or suggest printing anything other than a color functionality (i.e., ink) and therefore do not teach the printing device being used to print at least one functionality different from a functionality "color" that is used for producing the static or unchanging image as now recited in claim 32. The Examiner disagrees with this argument because the functionality as recited is not part of the positively recited structure of the printing device and instead is merely a functional recitation of a desired mode of operation of the printing device. Note that the particular functionality being printed (ink, varnish, text data, fragrance, etc.) does not change the structure of the printing device as recited. Therefore, since Katsumaru et al. teach all of the recited structure of the printing device, it is broadly capable of being used to print any desired functionality, such as one different from a functionality "color" that is used for producing the static or unchanging image, so as to provide different image characteristics to the dynamic or changing image.

In view of the above reasoning, the Examiner is not persuaded of any error in the above rejections.